

REMARKS

Claims 1-8 are currently pending in the application. Claims 1 and 6-8 are in independent form.

The drawings are objected to for failing to comply with 37 C.F.R. 1.84(p)(5). The specification describes figure 18 as showing a bone implant 10, 10', 10", 10"" whereas figure 18 only shows implant 10. The specification refers to figures 19 and 20 to have 22, 22', 22", 22"" and 26, 26', 26", 26"" whereas figures 18 and 19 lack these reference numbers. In response thereto, Applicants submit replacement drawings showing the corrected reference number for figures 18, 19, and 20. Reconsideration of the rejection is respectfully requested.

The specification is objected to because of informalities. In the brief description of the drawings (page 7), "FIGURE 17 is a cross-sectional view taken along line A - A in FIGURE 17 (itself). The Office Action holds that a figure cannot represent itself in a cross section view if only one figure is presented. In response thereto, Applicants have amended the specification to reference "line A – A in FIGURE 16". The Office Action further holds that there are no publications, etc in the specification as suggested by Applicants nor any citations provided by Applicants. In response thereto, Applicants have amended the specification on page 17 to delete reference to any publications or citations. Reconsideration of the objection is respectfully requested.

Claims 1-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,159,215 to Urbahns, et al. Specifically, the Office Action holds that Urbahns, et al. teaches an instrument for delivery of a vertebral body spacer. The instrument has a handle (90), an insertion rod (70), an implant gripper (76) with a gripping surface (168), and a moveable fixed pin (278), where one tooth is fixed in

reference and the tooth moves extending from the gripping surface. In regards to claims 6-8, Urbahns, et al. teaches the teeth are “sized for extension through aperture (pin hole) and engagement with edges defining aperture of spacer (implant). As shown in figure 10, teeth (pin) extend through apertures and engage edges to prevent spacer (implant) from sliding out from space between fingers (implant gripper).” The pins (278) enter the pin holes (17) of the implant (16). Thus, the Office Action holds that the implant is locked onto the device. The implant is then inserted into the spine, whereby the surgeon detaches the implant from the device. Reconsideration of the rejection under 35 U.S.C. § 102(b), as anticipated by Urbahns, et al., as applied to the claims is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986) it was stated: “For prior art to anticipate under §102 it has to meet every element of the claimed invention.”

In Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) it was stated: “Every element of the claimed invention must be literally present, arranged as in the claim.”

The Urbahns, et al. patent discloses a spacer-insertion instrument including a handle portion attached to a shaft portion, wherein the shaft portion includes a tip with an attachment portion having opposing fingers for grasping a spacer. (Col. 1, lines 18-27) The handle portion further includes a trigger which causes movement of the fingers to couple the spacer therebetween. (Col. 1, lines 42-51) In other words, pressure on the trigger causes the fingers to move either toward each other to grip a spacer, or away from each other to release a spacer (i.e. a surgeon squeezes the

trigger causing fingers 152,154 to press together – Col. 8, lines 33-42). There is not a finger which remains in a fixed position relative to the other finger. Both fingers move when pressure is applied to the trigger and engage or release the spacer at the same time. In figures 9 and 10, “each finger 152, 154 includes a tooth 278 extending outwardly from interior surface 158. Teeth 278 are generally triangular in shape and sized for extension through aperture 17 and engagement with edges 19 defining aperture 17 of spacer 16...[and] prevent spacer 16 from sliding out from the space 168 between the fingers 152, 154.” (Col. 6, lines 34-41) Each tooth is fixed on each finger. The teeth themselves are not movable. Rather, each finger (including a tooth attached thereto) is moveable. Either two parts of the Urbahns, et al. device move (the fingers) or no parts move (the teeth). There is no disclosure of a tooth or finger moving relative to a fixed tooth or finger.

In contradistinction, the present invention, as set forth in independent claim 1, provides for an implant insertion device including a gripping surface having a moveable pin and a fixed pin extending therefrom. The fixed pin does not move and remains in its place on the gripping surface. The moveable pin does move relative to the gripping surface, and can be moved into or out of a pin hole. To grip a bone implant, first the fixed pin is inserted in the first insertion pin hole (by moving the entire implant insertion device towards the first insertion pin hole), and then the moveable pin is driven into the second insertion pin hole (p. 16, lines 21-27). To detach a bone implant, first the moveable pin is detached from the second insertion pin hole by driving the moveable pin back into the implant gripper, and next the fixed pin is detached from the first insertion pin hole (by moving the entire implant insertion device away fro the first insertion pin hole) (p. 16, line 21 – p. 17, line 4). As set forth in independent claims 6-8, the moveable pin is moving, whereas the fixed pin remains fixed. During attachment and detachment of a bone implant, the moveable pin moves alone. The implant insertion device of the present invention does not function in the manner of the

Urbahns, et al. device in that the moveable pin and the fixed pin do not move together to grip an implant.

Therefore, since the Urbahns, et al. patent does not disclose a moveable pin and a fixed pin as set forth in the presently pending independent claims, the claims are patentable over the Urbahns, et al. patent and reconsideration of the rejection is respectfully requested.

The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above, and the prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

In view of the present amendment and foregoing remarks, reconsideration of the rejections and advancement of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

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